IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Tran Xuan et al.

Application No. 10/533,995

Filed: January 6, 2006

For: DYNAMIC IMAGE PRODUCTION METHOD AND SYSTEM

Group Art Unit: 2176

Examiner: James J. Debrow

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants request review of the final rejections in the Office action mailed February 3, 2009 ("Final Rejection") in connection with the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

The review is requested for at least the following reasons:

ARGUMENTS

Claims 18, 21-22, 24-25, 28-29, and 30-32 are pending in this application. Claims 18 and 30 are the independent claims.

Claims Rejections under 35 U.S.C. § 101

The Office rejected claims 18, 21, 22, 24, 25, 28, and 29 under 35 U.S.C. § 101. One skilled in the art with the context of the specification would not construe the claimed system to be merely software.

Consider a portion of claim 22, which recites:

A system according to claim 18, wherein processing means … is hosted in a server

Claim 18 could not be merely software at least for the reason that the images of claim 18 must be stored in a computer readable memory to accommodate the processing means being hosted in a server.

Additionally, consider a portion of the specification, which describes the system as including a computer server:

A system for dynamic generation of images intended to be transmitted to at least one remote terminal, comprising a *server*

Abstract (italics added). Furthermore, the images are described as being part of an image database, which would need some type of computer storage device. See Fig. 1, element 12, and *p.* 5, *ll.* 24-25.

One skilled in the art would clearly not construe "system" to be merely computer software, but would also include hardware.

Claims Rejections under 35 U.S.C. § 112 paragraphs 1 and 2 Objection to the Specification

The Office rejected claims 18, 30, 31, and 32 under 35 U.S.C. § 112 paragraphs 1 and 2, stating that the specification does not disclose a "description file," which is used in the claims. The Office objected to the specification as failing to provide proper antecedent basis for "description file." One skilled in the art would understand the term "description file" as being clearly supported by the specification.

One skilled in the art would understand several passages of the specification to being a description of a "description file".

Consider a first portion of the specification:

The description file of at least one of the source images includes a description of the characteristics of the source image and at least one tag adapted to cause a manipulation of all or part of the source image.

Specification, Abstract.

Additionally, relevant parts of the specification include the following:

> "The files stored in the image database 12 are … according to the SVG format
> … It [the file] is presented in the form of a text file which permits
> modifications to be carried out without launching an image editor. …
> [A]dditional tags are inserted by means of a conventional text editor…. Thus,
> as understood, the images stored in the image database 12 are comprised of
> universal files, that is, files common to all of the available terminals."

Specification, *p*. 5, *ll*. 11-25.

Additionally, consider the following passage:

> As previously indicated, said image is presented in the form of an SVG file,
> described using XML tags and comprising moreover additional tags making it
> universal, that is, suitable in principle to any type of support, subject to a
> manipulation.

p. 12, *ll*. 22-25.   One skilled in the art would clearly understand within the context of the specification the meaning of the term "description file of a source image" as recited in claims 18 and 30 to be the files stored in an image database as described above and in the specification.   Withdrawal of the rejections under 35 U.S.C. § 112 paragraphs 1 and 2, is respectfully requested.

Claims Rejections under 35 U.S.C. 103(a)

The Office rejected claims 18, 21, 22, and 28-32 under 35 U.S.C. 103(a) as being unpatentable over Spencer et al. (U.S. Pat. No. 7,109,985) (hereinafter "Spencer") in view of Wanderski et al., (U.S. Pat. No. 6,519,617) (hereinafter "Wanderski"). The Office rejected claims 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Spencer in view of Wanderski, and in further view of Huang et al., (U.S. Pub. No. 2002/0147748)(hereinafter "Huang"). However, no aspect of Spencer, Wanderski, or Huang either alone or in any combination disclose or suggest the elements of claims 18, 21-22, 24-25, 28-29.

Claims 18

Consider a portion of claim 18, which recites in part:

one or more **tags** adapted **to cause manipulation of all or part** of said source
image, and wherein said system comprises:
processing means for generating a modified description file by **replacement
of at least one tag of said one or more tags in the description file of said
source image by an instruction code according to argument values
conveyed by a request received from the at least one remote terminal**

The bolded elements are not disclosed or suggested by the cited prior art. The Office admits that the bolded portion is not disclosed by <u>Spencer</u>, but asserts that the bolded portion is disclosed or suggested by <u>Wanderski</u>. But, <u>Wanderski</u> does not work by "replacement" and there are no tags as recited in claim 18 in <u>Wanderski</u>.

In <u>Wanderski</u>, a DTD engine modifies an XML document to include tags that indicate desired transformations which account for values of dynamic factors. *c.* 7, *ll.* 61-63. So, <u>Wanderski</u> discloses manipulating images only at a top level and adding tags—not replacing a tag of an image file according to argument values. For example, in <u>Wanderski</u> an XML command can be added to a document to render an image in gray scale. See <u>Wanderski</u> at FIG. 5B and *c.* 11, *ll.* 57-60. But, there is simple no disclosure in <u>Wanderski</u> of a tag as recited in claim 18 that can cause manipulation of all or part of said source image that is "<u>replace[d]</u>" by "<u>an instruction code according to argument values</u> ... <u>from</u> ... [a] <u>remote terminal</u>."

Consider that the tags as recited in claim 18 can be used to create universal images so that the creator of the image can put the tags in the file with the image. The image can then be manipulated based on replacing the tags with an instruction code using argument values conveyed by a remote terminal to create an image for the remote terminal. See Specification, *p.* 5, *ll.* 11-23, and *p.* 6, *ll.* 8-14.

Additionally, consider the following advantages of the claimed invention that cannot be achieved by the methods described in the cited prior art. Tags are related to manipulation that may be applied to an image and tag replacement is operated according to argument values conveyed by a request received from a remote terminal. Therefore tag replacement can be done according to the specific needs of the remote terminal. In particular, the invention provides a method for generating images complying with display limitations of the remote terminal [Published App., Para. 6]. The remote terminal can send, for example, an indication of an image maximum size which can be displayed and tag "clipping" [Para. 68] (or tags "resize height" and resize "width" [Paras. 72-73]) will be used to generate a manipulated (clipped or resized) image, ready to be displayed on the remote terminal.

Neither <u>Spencer</u> nor <u>Huang</u> remedy the deficiencies of <u>Wanderski</u>. <u>Spencer</u> teaches a system that applies operators to acquired images. The operators of <u>Spencer</u> simply do not provide the advantages as described above. See <u>Spencer</u>, FIG. 1 & 2 and the discussion at *c.*

10, *ll*. 58-67. Note that in <u>Spencer</u> that the operators are applied to the image, but there is simple no disclosure in <u>Spencer</u> of a tag as recited in claim 18 that can cause manipulation of all or part of said source image that is "<u>replace[d]</u>" by "<u>an instruction code according to argument values</u> … <u>from</u> … [a] <u>remote terminal</u>."

Withdrawal of the rejection of claim 18 is requested. Since claims 21-22, 24-25, and 28-29 depend from claim 18, the withdrawal of the rejection of claims 21-22, 24-25, and 28-29 is requested for at least the same reasons as for claim 18. Additionally, since claim 30 recites similar limitations as claim 18, withdrawal of the rejection of claim 30 is requested for at least the same reasons as for claim 18. Since claims 31 and 32 depend from claim 30, withdrawal of the rejections of claims 31 and 32 is requested for at least the same reasons as for claim 30.

CONCLUSION

All outstanding objections and rejections have been overcome. It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is solicited.

In view of the above, Applicants respectfully request that these rejections be withdrawn and the application be allowed.

Respectfully submitted,

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